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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,785	12/29/2000	John Nelson	41934/23838	4216

7590
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07/18/2002

EXAMINER

KAM, CHIH MIN

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 07/18/2002

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/673,785

Applicant(s)

NELSON ET AL.

Examiner

Chih-Min Kam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. Claims 1-18 are pending.

Applicants' amendment and substituted specification including the abstract filed on May 6, 2002 (Paper Nos. 17 and 18, respectively) are acknowledged, and applicants' response has been fully considered. Claims 1-8 have been amended, and new claims 9-18 have been added.

Sequence Listing

2. A paper copy of sequence listing and CRF have been submitted. However, the CRF has error (see attached raw sequence listing error report). Appropriate correction is required. Applicants must comply with the requirements of the sequence rules (37 CFR 1.81-1.825) and provide a copy of sequence listing and CRF containing all the sequences.

Objection Withdrawn

3. The previous objection to the specification regarding the use of brackets ([..]) and the "SEQ ID NO:", is withdrawn in view of applicants submission of the substituted specification with correction made.

Objection Withdrawn

4. The previous rejection of claims 4-8 as being improper dependent claims, is withdrawn in view of applicants' amendment to the claim.

Claim Rejections - 35 USC § 112

5. The previous rejection of claims 1-3, under 35 U.S.C.112, first paragraph, is withdrawn in view of applicants' amendment to the claim and applicants' response at pages 6-9 in Paper No. 17.

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6. The previous rejection of claims 1-3, under 35 U.S.C.112, second paragraph, regarding the term “derived from”, “synthetic equivalent”, “consist of at least one modification chosen from the group comprising”, “tyrosine analogues”, “arginine analogues”, “capping the N terminal.....capping thiol groups of cysteines” or “Tic-OH”, is withdrawn in view of applicants’ amendment to the claim, and applicants’ response at pages 7 and 9 in Paper No. 17.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-18 are indefinite because of the use of the term “the peptide factor is modified such that at least one murine epidermal growth factor tyrosine amino acid residue is substituted with a tyrosine analogue or at least one murine epidermal growth factor arginine amino acid residue is substituted with an arginine analogue”. The term “the peptide factor is modified such that at least one murine epidermal growth factor tyrosine amino acid residue is substituted with a tyrosine analogue or at least one murine epidermal growth factor arginine amino acid residue is substituted with an arginine analogue” renders the claim indefinite; it is unclear what else is modified in the residues 33 to 42 of murine epidermal growth factor besides the modification at Tyr or Arg. Claims 2-4 and 7-18 are included in this rejection for being dependent on a rejected claim and not correcting the deficiency of the claim from which they depend.

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8. Claims 5-8 and 12-18 are indefinite because they lack essential steps as claimed in the method of binding a laminin receptor as an antagonist or agonist. The omitted step is the step of binding of a modified murine epidermal growth factor to the laminin receptor. Claims 7, 8 and 12-18 are included in the rejection because they are dependent on a rejected claim and do not correct the deficiency of the claim from which they depend.

9. Claim 7 recites the limitation "an antagonist" in line 2. There is insufficient antecedent basis for this limitation in the claim.

10. Claim 11 is indefinite because the claim is the same as claim 10.

11. Claim 13, for example, recites the limitation "the peptide factor" in line 1. There is insufficient antecedent basis for this limitation in the claim because claim 12 is a method claim, while claim 13 is a product claim. See also claim 14, 16 and 17.

Conclusions

12. No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph. D. can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D. *CMK*
Patent Examiner

July 16, 2002

Karen Cochrane Carlson
KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER